been non-final. The Applicants request further that the finality of the final Office Action mailed September 24, 2002 be also withdrawn.

The Applicants must continue to insist that there is no teaching, disclosure or suggestion in Throckmorton of a processor responsive to stored information data to output for display data *derived* from image data *and* information data and representing an interactive image, as required by claims 1 and 28 of the application. No image data will ever be *derived* from either the control commands to be executed by microprocessor 38 or the script that is used by real-time trigger 76, to which the final Office Action refers as information data, as required by the claimed invention. Rather, the control commands or the script will, at most, only *control* a display, as acknowledged in the final Office Action.

The Applicants appreciate the proffer of the Greene reference to show, inter alia, using a GUI to activate a modem may have been known *separately* at the time of the invention. However, 35 U.S.C. § 103(a) and the M.P.E.P. §706.02(j)(D) require the claimed *combination* of elements to have been obvious to persons of ordinary skill in the art at the time the invention was made, not just any particular individual element. Merely pointing to descriptions of one or another of the individual elements, such as, for example, activating a modem using a GUI, does not render the claimed *combination* of elements obvious.

"It is insufficient that the prior art [discloses] the components . . . either separately or used in other combinations; there must be some teaching, suggestion, or incentive to make the combination made by the inventor." *Northern Telecom, Inc. v. Datapoint Corp.*, 908 F.2d 931, 15 USPQ2d 1321 (Fed. Cir. 1990), *cert. denied*, 498 U.S. 920 (1990).

"When a rejection depends on a combination of prior art references, there must be some teaching, suggestion, or motivation to combine the references." *In re Rouffet*, 47 USPQ2d 1453, 1456 (Fed. Cir. 1998); see also M.P.E.P. § 2143.01. Virtually all inventions are combinations of old elements. *See In re Rouffet*, 47 USPQ2d at 1457. If identification of each claimed element in the prior art were sufficient to negate patentability, the Examiner could use the

claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. *See Id.* To prevent the use of hindsight based on the teachings of the patent application, the Examiner must show a motivation to combine the references in the manner suggested. *See Id.* at 1457-1458.

The Applicants must therefore reiterate their request for evidence to support the assertion that the combination of elements would have been obvious to persons of ordinary skill in the art at the time the invention was made. Otherwise, the assertion is traversed.

The final Office Action asserts at page 4 that "it would have been obvious to combine Throckmorton and Green, for the known proposition of a more user friendly interface." A more user friendly interface, however, has nothing to do with the use to which the final Office Action seeks to put Green, that is to support the establishment of a connection via a modem. Furthermore, there is no reason to suspect the user interface of Throckmorton was anything but friendly in the first place. The final Office Action has still supplied no motivation for the *proposed* modification of Throckmorton.

With respect to Aker, merely discussing what Aker may describe *separately* does not meet the requirements of 35 U.S.C. § 103(a) and the M.P.E.P. §706.02(j)(D) with respect to a showing that the *combination* of elements would have been obvious to persons of ordinary skill in the art at the time the invention was made.

The final Office Action offers Cina at page 5 as evidence that "it was well known in the art to generate image data with a specific size and resolution." The final Office Action used Official Notice to meet one of the claimed elements as part of the rejection. Cina, however, was not cited in the rejection at all. Furthermore, the Applicants are entitled to more than a showing that an individual element such as size or resolution may have been known *separately* a the time the invention was made. 35 U.S.C. § 103(a) and the M.P.E.P. §706.02(j)(D), requires a showing that such knowledge would have led persons

of ordinary skill in the art at the time the invention was made to view the *combination* of claimed elements to have been obvious.

The Applicants must reiterate their request for evidence to support the taking of Official Notice that the combination of elements would have been obvious to persons of ordinary skill in the art at the time the invention was made. Otherwise, the Official Notice is traversed.

As discussed above with respect to Aker, merely discussing what Cina may describe does not meet the requirements of 35 U.S.C. § 103(a) and the M.P.E.P. §706.02(j)(D) with respect to a showing that the *combination* of elements would have been obvious to persons of ordinary skill in the art at the time the invention was made.

Finally, with respect to the Nemirosky, Schutte and Chen references, the final Office Action used Official Notice to meet one of the claimed elements as part of the rejection. Neither Nemirosky, Schutte nor Chen, however, were cited in the rejections. Furthermore, as discussed above with respect to Aker, merely discussing what Nemirosky, Schutte or Chen may describe does not meet the requirements of 35 U.S.C. § 103(a) and the M.P.E.P. §706.02(j)(D) with respect to a showing that the *combination* of elements would have been obvious to persons of ordinary skill in the art at the time the invention was made.

The Applicants must reiterate their request for evidence to support the taking of Official Notice that the combination of elements would have been obvious to persons of ordinary skill in the art at the time the invention was made. Otherwise, the Official Notice is traversed.

Claim Rejections - 35 U.S.C. § 103:

The final Office Action rejects claims 1, 3, 4, 6 through 8, 10 through 14, 16 through 30, 32, 33, 35 through 37, 39 through 45, 66 and 68 under 35 U.S.C. § 103 as unpatentable over Throckmorton et al., US 5,818,441 in view of Green et al., US 5,664,110 and Aker (The Macintosh Companion). The rejection is again traversed. Withdrawal of the rejection is again respectfully requested.

Twice amended claim 1 recites, in pertinent part:

"a processor responsive to the stored information data to output for display data derived from said image data and said information data and representing an interactive image."

And twice amended claim 28 recites:

"responding to the stored information data by outputting for display data derived from said image data and said information data and representing an interactive image."

It is submitted that responding to stored information data by outputting for display data derived from image data and information data and representing an interactive image, as recited in twice amended claims 1 nor 28, is disclosed in neither Throckmorton, Green nor Aker.

Throckmorton discloses a system for providing information associated with a broadcast television program to a consumer. The broadcast television program or, more generally, "primary data stream" and associated information or "associated data" may be transmitted together by, e.g., "broadcast, cable or a package media such as cassettes and audio CDS" (see column 4, lines 9-11 of Throckmorton). On the receipt of the data, a consumer unit presents "the primary data stream to the consumer in the manner in which a typical consumer would expect to see the data presented" (see, e.g. column 6, lines 36-39 of Throckmorton). "The primary data stream is immediately rendered and the associated data is stored in local data storage 80" (see column 7, lines 66 to column 8, line 1 of Throckmorton).

The associated data is handled by the decoder 58, associated data protocol manager 60, communications manager 66 and associated components. In the case that "associated data" is received with the "primary data", the "associated data" is decoded by the decoder 58 and translated by the associated data protocol manager to a form useable by the communications manager 66. In addition, the communications manager 66 receives "associated data" from "telephone modems, ISDN modems, cable modems, wireless modems, satellite

modems, broadcast TV, radio and the like" (see column 6, line 35 to column 7, line 12) of Throckmorton. This first embodiment is not interactive.

Referring to column 8, lines 16-24 and Figures 4 and 5 of Throckmorton, a second embodiment includes interactive communication. In this embodiment, a two way communication channel 74 is connected to the communications manager 66 (see Figure 5 of Throckmorton). The two way communication channel may be "a conventional switched analogue telephone system interfaced to a modem, a digital switched system such as ISDN interfaced to an appropriate adapter card, a wide area network connected through an access device, satellite technologies, and the like" (see column 8 lines 57-63 of Throckmorton).

In the first embodiment, a consumer unit simply displays received "associated data" via a human interface (see column 8, lines 1-15 of Throckmorton). In the second embodiment, a consumer is able to access on-line services. For example, the "associated data" may comprise URL addresses to be accessed by the consumer (see column 9, lines 1-25 of Throckmorton).

Importantly, there is no disclosure of a processor responsive to stored information data to output for display data *derived* from image data and information data and representing an interactive image, as required by claims 1 and 28 of the application. Rather, the "primary data" of Throckmorton is rendered and displayed immediately and quite separately from the "associated data". The processing of the image data is not responsive to the stored associated data in Throckmorton.

This results in a vital difference between the disclosure of Throckmorton and the claimed invention. Throckmorton simply relates to the provision of separate "associated data" relating to "primary data". For example, one can imagine this being displayed as two separate windows on a PC monitor or using a PC to deal with the "associated data" in combination with a television receiving the "primary data" as a normal television broadcast.

In contrast, the present invention displays data derived from the image data and the information data in response to the information data. For example,

in the case of an electronic program guide, the displayed interactive image may include the image data.

This should not be confused with the display of "associated data" in Throckmorton at a time associated with the receipt of the "primary data". This is the display of "associated data" dependent on the "primary data", not the display of data derived from image data and the information data in response to the information data, as required by the claimed invention.

Furthermore, the final Office Action identifies the claimed image data and information data as being included in the "associated data" of Throckmorton. In this case, the Applicants understand that the claimed decoder for separating the image data and information data would, in Throckmorton, be the communications manager 66. Thus, while the final Office Action points out that the associated data of Throckmorton may be stored in local data storage 80 of Throckmorton, it is clear that the commands included in the associated data are dealt with by the real time trigger 76. These commands are not therefore stored.

Throckmorton therefore lacks a processor responsive to the stored information data to output for display data derived from said image data and said information data and representing an interactive image, as required by amended claim 1. Furthermore, these features are not taught in either Green or Aker.

As can appreciated from the specific embodiments of the invention described in the application, the generation of an interactive image in response to stored information data allows interactive image to be generated using stored templates, software and such like along with video data received in television signal for example. In contrast, the commands of Throckmorton are concerned with synchronizing the display of information with the arrival time of broadcast television signals.

The Applicants request respectfully some evidence be provided to support the assertion in the final Office Action at page 8 to the effect that 'it was well known in the art to for (sic) a user of a network data terminal device to utilize a GUI image in order to activate a modem and establish communication with a

remote site', and hence that it would have been obvious to modify Throckmorton. In the meanwhile, the assertion is traversed.

Green describes a remote ordering system arranged to provide a user with the ability to build and edit one or more lists and manipulate a display of the same information. The remote ordering system allows the user to order items from a merchant without having to travel to the merchant's location. The system comprises a modem for establishing a link with a merchant database (column 5, line 7). Data from the database can be displayed by the system. All that this reference really shows is that a modem can be used to connect a computer to a remote database.

Green relates to a dedicated remote ordering system. No image data, e.g. television signals, are broadcast in this system. The technology of Green would not therefore be considered by persons skilled in the art dealing with the broadcast of digital television signals and data for interactive display. Furthermore, Green neither teaches, discloses, nor suggests responding to stored information data by outputting for display data derived from image data and information data and representing an interactive image, as recited in claims 1 and 28.

This use of two different media enables broadband images to be transmitted in order to give a realistic simulation of a shopping environment, while allowing narrow band, transaction-specific information to be exchanged via a telephone line. This approach enhances realism without significantly increasing the system overheads. The approach is simply not disclosed or suggested in any cited reference.

Aker neither teaches, discloses, nor suggests responding to stored information data by outputting for display data derived from image data and information data and representing an interactive image, as recited in claims 1 and 28. Since neither Throckmorton, Green, nor Aker describe responding to stored information data by outputting for display data derived from image data

and information data and representing an interactive image separately, their combination cannot, either.

The Applicants request some motivation or suggestion to combine the teachings of Throckmorton, Green, and Aker, as required by 35 U.S.C. § 103(a) and the M.P.E.P. §706.02(j)(D), beyond the simple assertion that one or another of the elements may have been known in the art, or notoriously well known, or obvious.

The Applicants also request respectfully some evidence to support the taking of official notice at page 11 to the effect that it was well known in the art to generate image data with a specific size or resolution, and hence that it would have been obvious to modify Throckmorton. In the meanwhile, the assertion is traversed.

Furthermore, the Applicants request respectfully some evidence to support the taking of official notice at page 12, to the effect that it was well known in the art to issue credit cards, and hence that it would have been obvious to modify Throckmorton. In the meanwhile, the assertion is traversed.

Finally, M.P.E.P. § 2143.01 prohibits proposing a modification that renders a reference unsatisfactory for its intended use. The purpose intended for Throckmorton is "creating and transmitting associated data which provides the appearance of an interactive connection to secondary sources of information", as described at column 1, lines 10 through 12. Throckmorton believed that two-way communication would be too expensive, as described at column 1, lines 57 and 58. Throckmorton proposed therefor offering a consumer a *perception* of receiving interactive data, as described at column 2, lines 58 through 59, without otherwise tying up bandwidth.

If Throckmorton were modified as proposed in the final Office Action, however, the connection established by the modem would hog the bandwidth Throckmorton is seeking to preserve. The modification of Throckmorton proposed in the final Office Action would thus render Throckmorton unsuitable